

## Remarks

Claims 1 to 28 are pending in the application and all were rejected under 35 U.S.C. §102(b) in view of *Kabara* (EP0530861A2). Claims 1, 3 to 5, 7 to 10, 12, and 16 to 25 were rejected under 35 U.S.C. §112, first paragraph, because the examiner contends that sorbitol (which is recited in these claims) is not specifically named in the specification. The examiner also contends that: one would not arrive at a minimum dielectric constant of 25 from the data in the specification; and all fatty acids must be even numbered hydrocarbons 6-18 because all fatty acids are synthesized 2 c atoms at a time (citing Morrison, p. 1132, 1134).

On February 18, 2005, Applicants submitted a Terminal Disclaimer traversing an earlier rejection based on obviousness-type double patenting. Receipt of the terminal disclaimer has been acknowledged by the examiner. (Action, p.2.) It is assumed that the double-patenting rejection has been withdrawn.

The examiner's contentions that one would not include sorbitol or arrive at a minimum dielectric constant of 25 from the data in the application are incorrect. At page 23, lines 14 to 21 the specification discloses polarity or conductivity of a material being measured in terms of the dielectric constant, as well as the extremes of suitable dielectric constants. Materials at the *low* end have unacceptable dielectric "constants in the range of 15 to 25." Claim 11 recites a dielectric constant "greater than 25." Therefore, there is a disclosure and a teaching of a lower limit of a lipophilic polar solvent having a dielectric constant of greater than 25. Since sorbitol has a dielectric constant of 33.5, it is well within the teachings of the present application. Applicants respectfully submit that the rejection under 35 U.S.C. §112 should be withdrawn, and that this claim should be allowed. Sorbitol specifically, and dielectric constants above 25

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generally, are supported by the above-cited portion of the specification and there is no such teaching of the claimed range in the prior art.

As to the examiner's contention that claim 17 is not allowable because C7 cannot be a fatty acid, Applicants respectfully disagree. In the specification at page 5, lines 4 to 10, Applicants describe "a mixture of fatty acids (C<sub>6</sub> to C<sub>12</sub>) to solublize the fatty acids. In such a composition, the shorter-chained fatty acids (C<sub>6</sub> to C<sub>9</sub>) may actually assist the action of the hydrotrope by helping to solublize the longer species, and thereby improving the longer species' antimicrobial efficacy." In this passage, it is evident that Applicants were teaching that a C<sub>9</sub> fatty acid was indeed a "fatty acid" by the inventors' definition.

While Morrison (cited by the examiner) discusses the synthesis of fatty acids as taking place "two carbons at a time," there is nothing in Morrison that excludes a compound because it has an odd number of carbon atoms. Regardless, Morrison's definition is not controlling. Inventors are permitted to be their own lexicographers. *Lear Siegler, Inc. v. Aeroquip Corp.*, 773 F.2d 881, 889, 221 U.S.P.Q. 1025, 1031 (Fed. Cir. 1984). Here, the inventors were using the term fatty acids to include C<sub>9</sub>, which obviously has an odd number of carbon atoms. Thus, C<sub>7</sub> fatty acids are supported by the specification and are allowable under 35 U.S.C. §112 and over the art of record.

In their June 22, 2005 response, Applicants noted that *Kabara* (EP0530861A2) cannot anticipate or render obvious the claims of this application because it *requires* the presence of a fatty acid ester. The claims of this application expressly exclude compositions comprising fatty acid esters. The examiner seems to be taking the position that the "devoid of" language in the rejected claims is improper or ineffective, *per se*.

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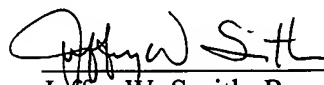
There is no *per se* rule against such negative limitations. *In re Bankowski*, 318 F.2d 778, 782-83, 138 U.S.P.Q. 75, 79 (CCPA 1963). The examiner has not cited any prior art equivalents or descriptions of fatty acid esters that would render the claims indefinite for possibly including the prior art teachings. Thus, nothing in the record supports the examiner's contention that the claims at issue are indefinite or anticipated by *Kabara*.

In *In re Duva*, 387 F.2d 402, 408, 156 U.S.P.Q. 90, 95 (CCPA 1967), the court held that the phrase "absent sufficient CN ions to prevent disposition induced by said palladous salt," was not indefinite since the claims "affirmatively specify the constitution" of the claimed subject matter. Similarly here, Applicants have affirmatively specified that the claimed composition is "devoid of sufficient fatty acid ester to substantially improve the antimicrobial activity of the composition." Applicants have limited their claims to exclude fatty acid esters because *Kabara* teaches the *need* for fatty acid esters. No further limitation is necessary under §112 or to avoid the prior art.

### **Conclusion**

For the foregoing reasons, Applicants respectfully submit that this application is allowable and should be passed to issue.

Respectfully submitted,

  
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